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EXAMINER

HELMER, S

#2

13M1 / 0424

ART UNIT

PAPER NUMBER

THOMAS C FEIX  
FEIX AND FEIX  
241 N SAN MATEO DRIVE  
SAN MATEO CA 94401

1304

DATE MAILED:

04/24/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474..
6. \_\_\_\_\_

Part II SUMMARY OF ACTION

1.  Claims 1-20 are pending in the application.

Of the above, claims 17-20 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-16 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims 1-20 are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

### Part III DETAILED ACTION

#### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-16, drawn to a method for producing an image on a one-way vision display panel, classified in Class 156, subclass 240.

Group II. Claims 17-20, drawn to a one-way vision display panel, classified in Class 40, subclass 615.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the product as claimed could be made by electrostatically printing directly on the perforated membrane instead of using a transfer medium.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Don Feix on 3/27/95 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in responding to this Office action. Claims 17-20 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 1-16 are rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Hill and further in view of EPO '845. The admitted prior art is disclosed in Fig. 2A and pages 1 and 2 of the present application. A plastic membrane 10 is prepared that has an opaque light-reflective surface 16 and a light absorbing surface 14. The membrane 10 is perforated by a plurality of spaced through-holes 20 separated by solid bar portions. An image 18 is printed onto the membrane 10. The admitted prior art does not disclose using transfer printing to decorate the membrane. Transfer printing to make one-way vision display panels, however, is well known as shown by Hill.

Hill discloses a one-way panel. An image is transferred from a transfer medium onto a one-way vision panel, (col. 9, line 67 to col. 10, line 15).

It would have been obvious to a person having ordinary skill in the art to have performed the printing of the admitted prior art by transfer printing, since Hill recognizes that transfer printing is effective for applying patterns for one-way vision panels, (col. 13, lines 27-36).

Hill does not disclose electrostatically transferring ink onto a transfer medium. Electrostatically transferring ink onto a transfer medium, however, is well known as shown, for example, by EPO '845.

EPO '845 discloses a transfer imaging system. Powdered ink is electrostatically transferred onto a paper transfer medium, (p. 7, lines 9-15), for temporarily holding an image for later transfer onto a transparent membrane, (p. 3, lines 11-19). Heat and/or pressure are used to transfer the image from the transfer medium onto a substrate, (p. 6, lines 12-26).

It would have been obvious to a person having ordinary skill in the art to have electrostatically transferred ink onto the transfer medium of the method of the admitted prior art and Hill, since EPO '845 recognizes that electrostatically transferring ink onto the transfer medium facilitates sign manufacturing, (p. 3, lines 23-28). Although EPO '845 does not disclose printing a reverse image, it is well known in the art that if only one transfer is made, it is sometimes necessary to print a reverse image to yield a proper image.

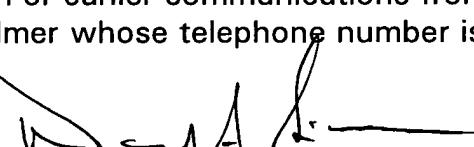
It is also well known in the art to electrostatically transfer liquid ink as opposed to powdered ink. Once the admitted prior art, Hill, and EPO '845 are combined, the image would be transferred onto only the solid bar portions of the perforated membrane.

It also would have been obvious to a skilled artisan to have electrostatically transferred ink onto a transfer medium for holding the image for later transfer to a

surface of a perforated transparent membrane for two reasons. First, EPO '845 already discloses transferring its image from the transfer medium as a reverse image, (p. 3, lines 23-28). Second, Hill recognizes that transfer printing can be used to apply a pattern layer to a perforated transparent sheets, (col. 13, lines 46-49). A skilled artisan would realize that this embodiment of Hill would require that a light-absorbing layer would have to be applied over the exposed side of the pattern layer (reverse image layer) to be operative as a one-way vision panel, (See Hill, full disclosure).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References A, B, M, and N of Form 892 are relevant.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven J. Helmer whose telephone number is (703) 308-0092.

  
DAVID A. SIMMONS  
SUPERVISORY PATENT EXAMINER  
ART UNIT 134

SJH  
April 1, 1995